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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/803,615

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Christopher Keith

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07/17/2007

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SEATTLE, WA 98101-2347

EXAMINER

SUBRAMANIAN, NARAYANSWAMY

ART UNIT

PAPER NUMBER

3692

MAIL DATE

DELIVERY MODE

07/17/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/803,615

Applicant(s)

KEITH, CHRISTOPHER

Examiner

Narayanswamy Subramanian

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 28-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 28-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 6/11/07, 6/29/07, 1/5/07
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This office action is in response to applicants' request for continued examination filed on April 24, 2007. Amendments to claims 1, 10 and 27 and addition of new claims 38-46 have been entered. Rejections made under 35 USC § 101 have been withdrawn in view of the amendments. Claims 1-10 and 28-46 are currently pending and have been examined. The rejections and response to arguments are stated below.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

3. Claims 1-10 and 28-46 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 28 and 38 recite the limitations "causing an order to be simultaneously represented", "facilitate an exchange" and "ensuring the order is executable". It is not clear as to what the applicants mean by these limitations. The metes and bounds of terms like "causing an order to be simultaneously represented", "facilitating", and "ensuring the order is executable" are unclear making the scope of the claims indeterminate. For instance it is not clear what the applicant means by the term "simultaneously represented". Does this mean that the order is simultaneously placed or simultaneously broadcast or simultaneously executed. Hence it is difficult to ascertain the scope of the claim. Similarly the metes and bounds of the term "facilitate" are not clear. It is also not clear what the term "ensuring the order is executable" entails. The response provided by the applicant in their communication does not cure these

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deficiencies. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26

USPQ2d 1057 (Fed. Cir. 1993). Appropriate clarification/correction is required. The dependent claims 2-10 and 29-37 are rejected for the same reason and by way of dependency on a rejected independent claim. Dependent claims contain similar ambiguities like “committing the conditional operation” and “to separately facilitate an exchange” making the scope of the claims indeterminate. Appropriate clarification/correction is required.

The art rejections that follow are interpreted in light of the rejections above.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-10 and 28-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lupien et al. (US Patent 5,101,353) in view of Korhammer et al. (US Patent 6,278,982 B1).

Claims 1, 28 and 38, Lupien discloses a method, a system and a computer-accessible medium having executable instructions stored thereon for operating an internal market, the method comprising: using a software process executing on a computer, automatically causing a portion or all of an order to be simultaneously represented in both the internal market and an external market, wherein the internal and external markets each have a plurality of market participants and separately facilitate an exchange between the market participants, and wherein

the same portion or all of the order is simultaneously represented in both the internal and external markets (See Lupien Abstract and Col 3 lines 31-42, broadcasting the order is interpreted to include representing the order in various markets); and automatically ensuring the order is executable by a market participant in at most one of the internal market and the external market, wherein the order is executable without chance of a duplicate execution in more than one of the internal and external markets (See Lupien Abstract and Col 3 lines 43-45, Col 4 lines 32-38, the division of orders ensures that the orders are executable by a market participant in at most one of the internal market and the external market and there is no duplication of orders).

Claims 2-6, 9-10, 29-33, 36-37, 39-43 and 46, Korhammer teaches the steps of automatically synchronizing performance of an operation at the internal market and the external market (See Korhammer Column 12 lines 7-30, coordination of split orders implies synchronization); causing a transaction performed in one of the internal and external markets to be performed in the other of the internal and external markets, the transaction being an operation to cancel or a post an order (See Korhammer Column 12 lines 7-30, causing a transaction to be performed is interpreted as intended use); causing an execute operation performed in one of the internal and external markets to cause a cancel operation to be performed in the other of the internal and external markets (See Korhammer Column 12 lines 7-30, to cause a cancel operation is interpreted as intended use); conditionally performing an operation in one of the internal and external markets, and committing the conditional operation after receiving confirmation from the other of the internal and external markets that the operation has been communicated to the other of the internal and external markets (See Korhammer Column 12 lines 7-30); providing a mechanism for coupling the internal and external markets such that only one of the internal and

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external markets maintains the order for execution by a market participant at either of the internal market or the external market (See Korhammer Column 11 lines 54-67, for execution by a market participant at either of the internal market or the external market is interpreted as intended use); re-synchronizing an order book containing orders at each of the internal and external markets before decoupling the internal and external markets, wherein the markets, once decoupled, are capable to separately facilitate an exchange between market participants (See Korhammer Column 12 lines 7-30, wherein the markets, once decoupled, are capable to separately facilitate an exchange between market participants is interpreted as intended use); the automatically ensuring is performed using a software process executing on a computer platform that communicates between the internal market and the external market (Inherent in the disclosure of Korhammer).

Claims 7-8, 34-35 and 44-45, Lupien does not explicitly teach the steps wherein when one of the internal and external markets is in fast symbol mode, the other of the internal and external markets operates as a router to route orders to the market in fast symbol mode without posting the order at the other of the internal and external markets and wherein an order can be executed at only the market in fast symbol mode. The limitations “to route orders to the market in fast symbol mode without posting the order at the other of the internal and external markets and wherein an order can be executed at only the market in fast symbol mode” are interpreted as intended use.

Official notice is taken executing orders in a market with short latencies, routing the orders to such markets with short latencies and adjusting the orders in the markets before separating the execution in the markets are old and well known in the art. These actions help an

investor to realize the best possible prices for his/her transaction in the most time efficient manner.

It would have been obvious to one of ordinary skill in the art to include these features to the invention of Lupien. The combination of disclosures would have helped an investor to realize the best possible prices for his/her transaction in the most time efficient manner.

Response to Arguments

6. Applicant's arguments with respect to pending claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

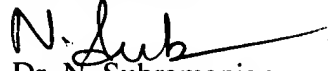
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Narayanswamy Subramanian whose telephone number is (571) 272-6751. The examiner can normally be reached Monday-Thursday from 8:30 AM to 7:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached at (571) 272-6783. The fax number for Formal or Official faxes and Draft to the Patent Office is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PMR or Public PAIR. Status information for unpublished applications is available through Private PMR only. For more information about the PMR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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A handwritten signature in black ink, appearing to read "N. Sub", with a long horizontal stroke extending to the right.

Dr. N. Subramanian

Primary Examiner

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July 8, 2007